REMARKS/ARGUMENTS

Applicant received the Office action of January 13, 2005, in which the Examiner: (1) provisionally rejected claims 1-2, 4-5, and 17-19 under 35 U.S.C. § 101 for statutory double patenting in light of claims 1-7, 12, 36-42, and 47 of copending Application Serial No. 10/351,188; (2) provisionally rejected claim 3 for non-statutory double patenting in light of claims 1-7, 12, 36-40, and 47 of copending Application Serial No. 10/351,188; (3) rejected claims 1 and 3-5 under 35 U.S.C. § 102(b) as anticipated by U.S. Patent No. 5,484,685 to *Tai et al.*; and (4) rejected claims 1 and 3-5 under 35 U.S.C. § 103(a) as obvious in light of *Tai et al.* Applicant files the instant amendment and response.

For clarity, Applicant has used the Examiner's section numbering system in responding to the Examiner's rejections (*e.g.*, III, IV, V, etc.).

III. Statutory Double Patenting

The Examiner has rejected claims 1-2, 4-5, and 17-19 under 35 U.S.C. § 101. The Examiner asserts that these claims "claim[ ] the same invention as that of claims 1-7, 12, 36-42, and 47 of copending Application No. 10/351,188 [(the '188 Application)]." Applicant respectfully disagrees.

In the context of statutory double patenting, "same invention" means identical subject matter. MPEP § 804(II)(A); *see also Studiengesellschaft Kohle mbH v. Northern Petrochemical Co.*, 784 F.2d 351, 355 (Fed. Cir. 1986). The test to determine whether identical subject matter is claimed is whether a claim in one application can be literally infringed without literally infringing a corresponding claim in the other application. MPEP § 804(II)(A); *see also In re Vogel*, 422 F.2d 438, 441 (C.C.P.A. 1970) ("A good test, and probably the only objective test, for 'same invention,' is whether one of the claims could be literally infringed without literally infringing the other."). That is clearly not the case in the instant application. While some claim scope may overlap or while some claims may be within the scope of others, none of the claims in this application are coterminus with the claims of the '188 Application.

For example, claims 5 and 40 of the '188 Application recites that the antenna may be quinone. Thus, assuming that all other claim limitations are met,

all of claims 1-5, 12, 36-40, and 47 of the '188 Application would be literally infringed by a composition having a quinone antenna. A quinone is not a phthalocyanine chromophore or a naphthalocyanine chromophore or their structural equivalents. Thus, none of claims 2-5 or 17-19 of the instant application, as amended, are unpatentable for statutory double patenting in light of claims 1-5, 12, 36-40, and 47 of the '188 Application.

Likewise, claim 6 of the '188 Application recites an antenna which readily absorbs laser radiation. Similarly, claim 41 of the '188 Application recites that the means for absorbing readily absorbs laser radiation. Phthalocyanine chromophores and naphthalocyanine chromophores and their structural equivalents are not the only antennae which absorb laser radiation. Thus, there are compounds which would literally infringe claims 6 and 41 of the '188 Application which would not literally infringe claims 2-5 and 17-19 of the instant application and claims 2-5 and 17-19 of the instant application are not unpatentable for statutory double patenting in light of claim 6 and/or 41 of the '188 Application.

Claim 7 of the '188 Application recites that the antenna is tuned to readily absorb infrared radiation. Similarly, claim 42 of the '188 Application recites that the means for absorbing readily absorbs infrared radiation. Phthalocyanine chromophores and naphthalocyanine chromophores and their structural equivalents are not the only antennae which absorb infrared radiation. Thus, there are compounds which would literally infringe claims 7 and 42 of the '188 Application which would not literally infringe claims 2-5 and 17-19 of the instant application. Therefore, claims 2-5 and 17-19 of the instant application are not unpatentable for statutory double patenting in light of claim 7 and/or 42 of the '188 Application.

For at least the foregoing reasons, Applicant respectfully request that the Examiner reconsider and withdraw his statutory double patenting rejection.

IV. Non-Statutory Double Patenting

The Examiner has provisionally rejected claim 3 based on obviousness-type double patenting over claims 1-7, 12, 36-40, and 47 of the '188 Application.

If the '188 Application issues as a U.S. Patent, Applicant will file a terminal disclaimer in compliance with 37 C.F.R. § 1.321(c). At such time, the terminal disclaimer will obviate this rejection.

V. 102(b) Rejection over U.S. Patent No. 5,484,685 to *Tai et al.*

The Examiner has rejected claims 1 and 3-5 as anticipated under 35 U.S.C. § 102(b) in light of *Tai et al.* Applicants have canceled claim 1, amended (formerly dependent) claim 2 to include the elements of claim 1, and amended claims 3-5 to depend from claim 2. Claim 2 is not under rejection in view of *Tai et al.* For at least these reasons, Applicant believes claims 2-5, as amended, are allowable. Additionally, because claim 2 is allowable, claims 17-19 are also allowable as indicated by the Examiner on page 2 of the Office action of January 13, 2005. Applicant respectfully requests a timely Notice of Allowance be issued.

VI. 103(a) Rejection over U.S. Patent No. 5,484,685 to *Tai et al.*

The Examiner has rejected claims 1 and 3-5 as obvious under 35 U.S.C. § 103(a) in light of *Tai et al.* Applicants have canceled claim 1, amended (formerly dependent) claim 2 to include the elements of claim 1, and amended claims 3-5 to depend from claim 2. Claim 2 is not under rejection in view of *Tai et al.* For at least these reasons, Applicant believes claims 2-5, as amended, are allowable. Additionally, because claim 2 is allowable, claims 17-19 are also allowable as indicated by the Examiner on page 2 of the Office action of January 13, 2005. Applicant respectfully requests a timely Notice of Allowance be issued.

CONCLUSION

Applicant believes he has fully responded to the Office action of January 13, 2005. Applicant respectfully requests that the Examiner reconsider his rejections and issue a Notice of Allowance in this case.

It is believed that no extensions of time or fees are required, beyond those that may otherwise be provided for in documents accompanying this paper. However, in the event that additional extensions of time are necessary to allow consideration of this paper, such extensions are hereby petitioned under 37 C.F.R. § 1.136(a), and any fees required (including fees for net

addition of claims) are hereby authorized to be charged to Hewlett-Packard Development Company's Deposit Account No. 08-2025.

Respectfully submitted,

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